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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,705	01/02/2004	Philip S. Siegel	067439.0155	3801

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/750,705	Applicant(s) SIEGEL, PHILIP S.	
	Examiner Jonathan Ouellette	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20040625, 20040318</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-10, 13, and 15-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Schwab et al. (US 2002/0019777 A1).**
3. As per **independent Claims 1, 20, and 22**, Schwab discloses a method (system, computer product) for processing returned items of merchandise, comprising the steps of: receiving a returned item at a return center (Para 0009); accessing one or more return rules of a merchant associated with the item (Para 0009, return policy guidelines; Para 0012); and processing the return in accordance with the return rules (Para 0009, pre-established procedures; Para 0024):
4. As per Claim 2, Schwab discloses wherein the method is performed by a third party on behalf of the merchant (abstract).
5. As per Claim 3, Schwab discloses wherein the method is performed for multiple merchants (Para 0021).
6. As per Claim 4, Schwab discloses wherein the processing step is performed by determining the eligibility of the return (Para 0009).

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7. As per Claim 5, Schwab discloses electronically delivering notice of the return to a merchant associated with the return (Para 0009-0014, Receive authentication from merchant).
8. As per Claim 6, Schwab discloses wherein the processing step is performed by determining a final destination of the return (Para 0009, return to merchant or manufacture).
9. As per Claim 7, Schwab discloses wherein the processing step is performed by determining disposition of the return (return to manufacturer or retailer as instructed).
10. As per Claims 8, 21, and 23, Schwab discloses wherein the accessing step is performed via the Internet (Para 0011).
11. As per Claim 9, Schwab discloses wherein the processing step is performed by returning an ineligible return to the customer (return rejected).
12. As per Claim 10, Schwab discloses wherein the processing step is performed by shipping the item to a location maintained by a merchant associated with the item (Para 0016).
13. As per Claim 13, Schwab discloses labeling the item for subsequent processing (Para 0020 – Reshipping to merchant or manufacturer).
14. As per Claim 15, Schwab discloses wherein the receiving step is performed by receiving the item directly from a customer (Para 0050).
15. As per Claim 16, Schwab discloses inspecting the item at the returns center.
16. As per Claim 17, Schwab discloses consolidating items to be shipped to a common destination (Para 0050, Bundle).
17. As per Claim 18, Schwab discloses crediting an account associated with a customer associated with the return (Para 0050, Credit).

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18. As per Claim 19, Schwab discloses accessing transaction data associated with the item
(ReturnCERT, Para 0050).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 20. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

Schwab in view of Roman et al. (US 2002/0010634 A1).

21. As per Claim 11, Schwab fails to disclose wherein the processing step is performed by assigning the item to an on-line auction.
22. However, Roman discloses a system for processing returns and disposing of the returns using an Internet auction web site (Para 0024).
23. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included disposing of the collected product using an auction or Internet auction web site, as disclosed by Roman in the system disclosed by Schwab, for the advantage of providing a method (system) for enabling local return of remotely purchased products, with the ability to increase system cost effectiveness by offering several channels for disposing of the returned merchandise.

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24. As per Claim 12, Schwab fails to disclose wherein the processing step is performed by shipping the item to a re-purchaser.
25. However, Roman discloses a system for processing returns and disposing of the returns using an Internet auction web site (Para 0024), and it would have been obvious to one of ordinary skill at the time the invention was made to ship merchandise to an auction winner a common method of e-commerce.
26. **Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schwab.**
27. As per Claim 14, Schwab fails to expressly disclose wherein the receiving step is performed by receiving the item from a carrier.
28. However, it would have been obvious for the consumer to mail the product to the third-party administrator instead of hand delivering it, the purpose of hand delivering is to credit the consumer immediately at the establishment (no delay as is common with the return of e-retailer or catalog goods).

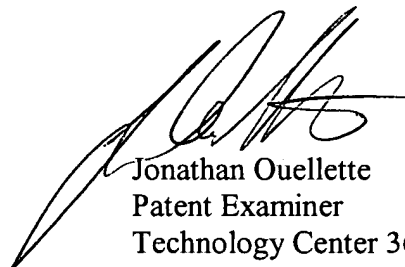
Conclusion

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
30. Additional Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.
31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

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32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (703) 872-9306 for all official communications.
33. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

October 28, 2005



Jonathan Ouellette
Patent Examiner
Technology Center 3600